

REMARKS

In the Office Action mailed December 23, 2008, the Office noted that claims 14-28 were pending and rejected claims 14-28. Claim 14 has been amended, claims 27 and 28 have been canceled, and, thus, in view of the foregoing, claims 14-26 remain pending for reconsideration which is requested. No new matter has been added. The Office's rejections are traversed below.

CLAIM OBJECTION

Claim 28 stands objected to for informalities. In particular, the Office asserts that the claim is improperly dependent. The Applicants have cancelled claim 28.

Withdrawal of the objection is respectfully requested.

REJECTIONS under 35 U.S.C. § 102

Claims 14-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Araki, U.S. Patent Publication No. 2002/0110068. The Applicants respectfully disagree and traverse the rejection with an argument and amendment.

Araki discusses a recording apparatus capable of detecting an accurate tracking error even if a reflectance or a transmittance of respective information recording layers varies when information is recorded onto a multilayer optical information recording medium having a plurality of information

recording layers.

Claim 14 has been amended to additionally include the features of claim 28. On page 5 of the Office Action, the Office asserts that "wherein the recording device records control information into the unrecorded area after the recording of the record information into the second recording layer is ended," is inherent.

However, the Federal Circuit stated in the case of *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364,

"...anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation." 290 F.3d at 1373 (emphasis original).

As Araki does not disclose, suggest or teach that some data is recorded into the unrecorded area 32 at all, it is not necessary to record control information in the unrecorded area. In other words, Araki does not disclose, suggest or teach whether or not some data is recorded into the unrecorded area 32 or not. Thus, the choice to do so is not necessary, and therefore, not inherent.

In addition, in the second embodiment of Araki (see paragraphs 0057 to 0062), the information is recorded onto all areas in the deepest layer and then the operation progresses to the upper layer when no unrecorded area 32 remains. This means that Araki merely discloses that the information is recorded into the recording layers sequentially from the deepest layer to the upper layer, and that Araki does not disclose the novel feature

of amended claim 14 such that (i) the record information is recorded into the first recording layer, and then (ii) the record information is recorded into the second recording layer, and then (iii) control information is recorded into the unrecorded area in the first recording layer.

For at least the reasons stated above, claim 14 and the claims dependent therefrom are not anticipated by Araki.

Withdrawal of the rejections is respectfully requested.

SUMMARY

It is submitted that the claims satisfy the requirements of 35 U.S.C. §§ 102. It is also submitted that claims 14-26 continue to be allowable. It is further submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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